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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,185	08/23/2001	Charles W. Propst Jr	TPP 30482 A	9479

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EXAMINER	
BRUENJES, CHRISTOPHER P	
ART UNIT	**PAPER NUMBER**
1772	

DATE MAILED: 05/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/914,185	PROPST JR, CHARLES W.	
	Examiner	Art Unit	
	Christopher P. Bruenjes	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 March 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *5 and 7* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *5 and 7* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

WITHDRAWN REJECTIONS

1. The claim objections and 35 U.S.C. 112 rejections of claims 5 and 7 of record in the Office Action mailed December 22, 2005, Pages 2-3 Paragraphs 4 and 6 have been withdrawn due to applicant's amendments in the Paper filed March 22, 2006.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claim 5 is rejected under 35 U.S.C. 102(e) as being anticipated by Wang et al (USPN 6,048,679).

Wang et al anticipate a support (see abstract), which is a paper layer (col.9, l.2-5), is coated in direct contact with a film of conductive polymeric composition represented by the antistatic layer of Wang et al (see abstract). The polymeric

composition is a dried layer formed from an intermediate composition comprising an aqueous solution (col.4, l.66-67). The intermediate composition comprises a methyl methacrylate polymer base containing a quaternary ammonium compound (col.3, l.27-61). The composition further comprises an ethylenically unsaturated monomer such as methyl methacrylate (col.5, l.41-48). Claim 5 is in product by process form, the film on the paper layer being formed by drying the intermediate composition. The process by which a product is made is not distinguishing in a product-by-process claim, unless evidence is provided that a different product is made by the process (In re Thorpe 227 USPQ 964). The limitation of "1 to 10wt%" for the amount of the quaternary ammonium compound is not seen as limiting, since none of the relative concentrations of the other components in the solution, such as methyl methacrylate, or polyethylene wax are taught in the claim. Furthermore, since the amount of the polymeric composition used to form the film is not disclosed, then the exact nature of the film cannot be ascertained, since the final amount of the quaternary ammonium compound in the film cannot be specifically determined. Clearly a film within the scope of that taught by applicant can be formed by Wang's process, since without the teaching of relative amounts of other components, or amount of the composition used to form the film,

the limitation of "1 to 10wt%" in the product by process claim 5, cannot be seen as having any distinguishing value. The composition further comprises a polyethylene wax (col.4, l.34-54). The polymeric composition is deposited directly on and in contact with said paper in an aqueous form and dried to form said film of polymeric composition (col.6, l.24-37). The composition inherently imparts a static dissipative property and a conductive property to the paper layer because the antistatic layer formed of the composition of Wang et al is used to overcome the accumulation of static charges by providing the antistatic layer or electrically conductive layer (col.1, l.60-63). Therefore, inherently the layer provides static dissipative and conductive properties in order to perform its intended function and since the layer is formed of the same materials as the claimed invention and the same composition must have the same properties.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at

> the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wang et al in view of Lu et al (USPN 5,130,177).

Wang et al teach all that is claimed in claim 5 as shown above, and teach that the antistatic layer or film containing a conductive polymeric composition is coated on photographic paper in order to impart antistatic protection to the photographic paper (col.1, l.32-65). Lu et al also teach adding lubricant and antistatic layers to photographic paper (see abstract). Lu et al further teach that in addition to the quaternary ammonium compound and polymer base in the antistatic layer, additives such as pigments are added to provide the layer with a certain color. Lu et al specifically teaches adding zinc oxide as a

suitable pigment to be employed within the aqueous dispersion prior to drying the coating (col.5, l.1-10 and l.36-50). One of ordinary skill in the art would have recognized that zinc oxide particles are added to the intermediate composition used to form an antistatic coating on photographic paper, in order to provide a certain color to the photographic paper, as taught by Lu et al. Furthermore, one of ordinary skill in the art would have recognized that Wang et al and Lu et al are analogous insofar as both references are concerned with forming photographic papers containing antistatic layers.

Therefore, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to add an aqueous dispersion of zinc oxide particles to the intermediate composition of the antistatic layer of Wang et al, in order to provide the photographic paper of Wang et al with a desired color, as taught by Lu et al.

ANSWERS TO APPLICANT'S ARGUMENTS

7. Applicant's arguments regarding the claim objection and the 35 U.S.C. 112 rejections of record have been considered but are moot since the objection and rejections have been withdrawn.

8. Applicant's arguments regarding the 35 U.S.C. 102 rejection of claim 5 as anticipated by Wang et al have been fully considered but they are not persuasive.

In response to Applicant's argument that Wang et al fails to teach the film of conductive polymer directly contacting the paper layer, it is agreed that Wang et al teaches that the photographic layer is applied directly to the support layer. However, Wang et al does not teach that the antistatic layer is applied to the photographic layer. Instead Wang et al teaches that the photographic layer is superposed on the support and the antistatic layer is superposed on the support (col.2, l.61-63). Therefore, Wang et al teaches that one surface of the support contains the photographic layer superposed on it, and the other surface of the support contains the antistatic layer superposed on it. This suggestion of the photographic layer and antistatic layers being on opposite surfaces of the paper support layer is reinforced by the teaching in Wang et al that in photographic elements, auxiliary layers such as an antistatic layer are provided on the back side of the support in order to enhance the photographic or physical quality of the photographic light sensitive materials (col.1, l.40-48). Thus, Wang et al teaches that the antistatic layer is directly contacting one side of the

support while the photographic layer is directly contacting the opposite side of the support.

In response to Applicant's argument regarding changing the range of the amount of quaternary ammonium compound see the rejection above with regard to claim 5.

9. Applicant's arguments regarding the 35 U.S.C. 103 rejection of claim 7 over Wang et al in view of Lu et al have been fully considered but they are not persuasive.

In response to Applicant's argument that Lu et al fails to cure the deficiencies of Wang et al with regard to claim 5, see the response to the arguments regarding claim 5.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, the motivation for

combining the reference is found directly in Wang et al and Lu et al as shown above in the 35 U.S.C. 103 rejection.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher P. Bruenjes whose telephone number is 571-272-1489. The examiner can normally be reached on Monday thru Friday from 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher P Bruenjes
Examiner
Art Unit 1772

CPB CPB
May 10, 2006

HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

5/10/06